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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,570	03/19/2004	Donn P. Cummings	DEKA:328US	7081
32425 7590 09/18/2007 FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701			EXAMINER KUBELIK, ANNE R	
			ART UNIT 1638	PAPER NUMBER
			MAIL DATE 09/18/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/804,570	Applicant(s) CUMMINGS, DONN P.	
	Examiner Anne R. Kubelik	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 July 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,5-9,11-17 and 19 is/are allowed.
- 6) ☒ Claim(s) 20-26 is/are rejected.
- 7) ☒ Claim(s) 3-4, 10 and 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-26 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The objection to the specification is withdrawn in light of Applicant's Deposit Statement filed 10 July 2007.
4. The rejection of claims 1-26 under 35 USC 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention is withdrawn in light of Applicant's Deposit Statement filed 10 July 2007.

### ***Claim Objections***

5. Claims 3-4 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claimed plants do not have all the characteristics of the plant population of claim 2, that is, they do not consist of variety I071535. Thus, the claims do not properly depend from the parent claim. The objection is repeated for the reasons of record as set forth in the Office action mailed 11 April 2007. Applicant's arguments filed 10 July 2007 have been fully considered but they are not persuasive.

Applicant urges that claim 4 requires the population of claim 2 be essentially from from hybrid seed; nothing in claim 2 requires these elements (response pg 2).

This is not found persuasive because claim 2 is drawn to “A population of seed of the corn variety I071535” [emphasis added], not a population comprising corn variety I071535. No other seed can be in the population of claim 2; thus, claim 4 fails to further limit claim 2.

Applicant urges that the dictionary definitions of “population” and “homozygous”, neither of which were sent, indicate that nothing would require the population of claim 2 to be homozygous (response pg 2-3).

This is not found persuasive for the reasons indicated above.

6. Claims 10 and 18 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claimed plants do not have all the characteristics of the plant of claim 5; thus, the claims do not properly depend from the parent claim. The objection is repeated for the reasons of record as set forth in the Office action mailed 11 April 2007. Applicant's arguments filed 10 July 2007 have been fully considered but they are not persuasive.

Applicant urges that in another case an Appeal was decided in Applicant's favor on this issue (response pg 3).

This is not found persuasive because the Decision states: “The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.”

***Claim Rejections - 35 USC § 112***

7. Claims 20-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Dependent claims are included in all rejections. The portion of the rejection below is repeated for the reasons of record as set forth in the Office action mailed 11 April 2007; the other rejections are withdrawn in light of Applicant's Deposit Statement filed 10 July 200. Applicant's arguments filed 10 July 2007 have been fully considered but they are not persuasive.

Claims 20 and 25 are indefinite in their reference to a plurality of paired chromosomes and genetic loci, as corn plants inherently comprise these features. Do the claims mean that these are additional chromosomes and loci?

Applicant urges that the terms are present to serve as antecedent basis for the plants defined by the claims, and not that additional loci or chromosomes need be present (response pg 5).

This is not found persuasive because the terms are confusing and appear to refer to additional chromosomes and loci. It is suggest that the claims be amended to obviate this rejection.

***Claim Rejections - 35 USC §§ 102 - 103***

8. Claim 24 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Rosenbrook (1992, US Patent 5,097,095). The rejection is repeated for the reasons of record as set forth in the Office action mailed 11 April 2007. Applicant's arguments filed 10 July 2007 have been fully considered but they are not persuasive.

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The claimed converted plants appear to have “substantially all” of the traits of the PHM10 plants taught by Rosenbrook. PHM10 has the same cob color (pink), glume color (green), silk color (green-yellow), and anther color (green-yellow), for example, as I071535. The plants also share similar scores on traits that are affected by environment, *e.g.*, plant height, seed content, lodging score and mean yield. Any differences are the new traits in the converted plants.

The prior art plants differ from the claimed plants only by their method of manufacture. However, the claimed method of making the converted plants would not distinguish them over the corn plants taught by the prior art. See *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), which teaches that a product-by-process claim may be properly rejectable over prior art teaching the same product produced by a different process, if the process of making the product fails to distinguish the two products.

Applicant urges that no showing that the reference actually does teach the claim limitations was made, and numerous morphological differences differ between the varieties, with no basis to conclude the plants could express the traits under any environmental conditions (response pg 5).

This is not found persuasive. Applicant has not pointed to any Mendelian traits that differ between the varieties, given that the claim is drawn to a converted plant of I071535 that expresses at least one new trait relative to I071535. PHM10 appears to express “at least one new trait” relative to I071535, as well as numerous traits in common. Traits that are affected by environment could be the same or they could be “new traits”; the Examiner cannot judge without growing the plants side-by-side. However, the Office is not equipped to conduct experimentation in order to determine whether Applicant’s composition differs, and, if so, to

what extent, from the discussed reference. Therefore, with the showing of the reference, the burden of establishing non-anticipation by objective evidence is shifted to the Applicants.

Applicant urges that the action appears to be alleging that the plants may be the same, with no attempt to show the variety anticipates the claims; each and every element must be shown to be present (response pg 6).

This is not found persuasive because the “at least one new trait” can be a trait or traits of any kind. PHM10 thus does anticipate each and every element.

Applicant urges that inherent characteristics must flow from the prior art (response pg 3).

This is not found persuasive because the “at least one new trait” can be a trait or traits of any kind.

9. Claim 24 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Johnson (2002, US Patent 6,444,884). The rejection is repeated for the reasons of record as set forth in the Office action mailed 11 April 2007. Applicant's arguments filed 10 July 2007 have been fully considered but they are not persuasive.

The claimed converted plants appear to have “substantially all” of the traits of the I014738 plants taught by Johnson. I014738 has the same cob color (pink), glume color (green), silk color (green-yellow), and anther color (green-yellow), for example, as I071535. The plants also share similar scores on traits that are affected by environment, *e.g.*, plant height, seed content, lodging score and mean yield. Any differences are the new traits in the converted plants.

The prior art plants differ from the claimed plants only by their method of manufacture. However, the claimed method of making the converted plants would not distinguish them over the corn plants taught by the prior art. See *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), which teaches that

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a product-by-process claim may be properly rejectable over prior art teaching the same product produced by a different process, if the process of making the product fails to distinguish the two products.

Applicant urges that no showing that the reference actually does teach the claim limitations was made, and numerous morphological differences differ between the varieties, with no basis to conclude the plants could express the traits under any environmental conditions (response pg 5).

This is not found persuasive. Applicant has not pointed to any Mendelian traits that differ between the varieties, given that the claim is drawn to a converted plant of I071535 that expresses at least one new trait relative to I071535. PHM10 appears to express “at least one new trait” relative to I071535, as well as numerous traits in common. Traits that are affected by environment could be the same or they could be “new traits”; the Examiner cannot judge without growing the plants side-by-side. However, the Office is not equipped to conduct experimentation in order to determine whether Applicant’s composition differs, and, if so, to what extent, from the discussed reference. Therefore, with the showing of the reference, the burden of establishing non-anticipation by objective evidence is shifted to the Applicants.

Applicant urges that the action appears to be alleging that the plants may be the same, with no attempt to show the variety anticipates the claims; each and every element must be shown to be present (response pg 6).

This is not found persuasive because the “at least one new trait” can be a trait or traits of any kind. PHM10 thus does anticipate each and every element.

Applicant urges that inherent characteristics must flow from the prior art (response pg 3).



This is not found persuasive because the "at least one new trait" can be a trait or traits of any kind.

10. Claims 1-2, 5-9, 11-17 and 19 are allowed.
11. Claims 3-4, 10 and 18 would be allowable if written to overcome the objections detailed above.
12. Claims 20-23 and 25-26 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

### *Conclusion*

13. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (571) 272-0801. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975.

The central fax number for official correspondence is (571) 273-8300.

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Anne Kubelik, Ph.D.  
September 12, 2007

/Anne Kubelik/  
Primary Examiner